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APPLICATION NO.	FILED DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/892,977	06/27/2001	Kirk D. Smith	WTI-2-CON	4764
22827	7590	10/08/2003		
DORITY & MANNING, P.A.			EXAMINER	
POST OFFICE BOX 1449			JUSKA, CHERYL ANN	
GREENVILLE, SC 29602-1449				
			ART UNIT	PAPER NUMBER
			1771	

DATE MAILED: 10/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/892,977	SMITH ET AL.
Examiner	Art Unit	
Cheryl Juska	1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 02 June 2003 .

2a)  This action is **FINAL**.                    2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 74-112 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 74-112 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12)  The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

14)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a)  The translation of the foreign language provisional application has been received.

15)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1)  Notice of References Cited (PTO-892) 4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948) 5)  Notice of Informal Patent Application (PTO-152)  
3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_ 6)  Other: \_\_\_\_

**DETAILED ACTION**

***Response to Amendment***

1. The amendment filed June 2, 2003, has been entered. Claims 50-73 have been cancelled as requested. new claims 74-112 have been added.
2. The cancellation of claims 50-73 renders moot the rejections set forth in the last Office Action.

***Claim Rejections - 35 USC § 102/103***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 74, 78, 79, 81-87, 89, 90, 92-95, 97-102, 104, 105, 107, 108, 110, and 112 are rejected under 35 USC 102(b) as being anticipated by, or in the alternative, under 35 USC 103(a) as being unpatentable over US 4,242,394 issued to Leib et al.

Leib teaches a reinforced primary backing for a tufted pile fabric (abstract). Said reinforcing backing comprises a nonwoven capping layer of staple fibers, a reinforcing layer, and

a woven backing (abstract, col. 2, lines 43-47). The capping layer is needled into and through the reinforcing layer and woven backing layer (abstract and col. 2, lines 33-38). The reinforcing layer may be a spunbond polypropylene nonwoven comprising continuous filaments which are thermally bonded at the filament crossover points (i.e., fused) (col. 2, lines 48-63). The woven backing layer is a conventional primary backing of a woven scrim of polypropylene monofilament ribbon strands as taught by US 3,605,666 issued to Kimmel et al. and US 3,817,817 issued to Pickens et al. (col. 2, lines 64-68). Pickens exemplifies a scrim having 12 ends by 8 picks (12 x 8 count) and weighing 2.75 oz/yd<sup>2</sup> but explicitly teaches other configurations may be substituted (col. 3, lines 1-10). Leib exemplifies a 24 x 13 count woven scrim. The Leib primary backing is tufted, backsized, and optionally bonded to a secondary backing.

Thus, Leib teaches the present invention with the exception of the claimed dimensional stability. However, it is reasonable to presume that the Leib invention inherently possesses said dimensional stability. Support for said presumption is in the use of like materials (i.e., woven polypropylene monofilament scrim and bonded polypropylene nonwoven) and the use of like processes (i.e., needlepunching said scrim and said nonwoven into a primary backing and then tufting said primary backing). The burden is upon Applicant to prove otherwise. *In re Fitzgerald*, 205 USPQ 495. In the alternative, the claimed dimensional stability would obviously have been present once the Leib invention is provided. Note *In re Best*, 195 USPQ 433, footnote 4 (CCPA 1977) as to the providing of this rejection under 35 USC 103 in addition to the rejection made above under 35 USC 102. Therefore, claims 74, 78, 79, 81-87, 89, 90, 92-95, 97-

102, 104, 105, 107, 108, 110, and 112 are rejected as being anticipated or obvious over the cited Leib patent.

***Claim Rejections - 35 USC § 103***

6. Claims 75-77 and 96 are rejected under 35 USC 103(a) as being unpatentable over the cited Leib reference.

Leib is silent with respect to the basis weight of the nonwoven component. However, spunbond nonwoven fabrics of the presently claimed basis weight are well-known in the art. Specifically, Leib teaches a spunbond fabric, such as DuPont's Typar™ (col. 2, lines 57-60). Applicant is hereby given Official Notice that Typar™ is readily available in weights within the ranges presently claimed. As such, it would have been obvious to a person having ordinary skill in the art to utilize a spunbond nonwoven within the basis weight claimed for the invention of Leib. Such a modification would have been motivated by the availability of said nonwoven. The Examiner notes that the facts asserted to be common and well-known are capable of instant and unquestionable demonstration as being well-known. To adequately traverse such a finding, an Applicant must specifically point out the supposed errors in the Examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. Spunbond nonwovens of the claimed basis weight are so common in the art that Leib may already be using them. Therefore, claims 75-77 and 96 are rejected as being obvious over the cited prior art.

7. Claim 88 is rejected under 35 USC 103(a) as being unpatentable over the cited Leib patent in view of US 5,213,735 issued to Schneider et al.

Leib fails to teach a needled nonwoven fabric as the reinforcing layer. However, it is well known in the art that spunbond fabrics can be thermally bonded and/or needlepunched. For example, Schneider teaches a needlepunched spunbond fabric with increased strength, integrity, and basis weight uniformity and with high production speeds (abstract, col. 1, lines 13-21 and col. 1, line 59-col. 2, line 16). Thus, it would have been obvious to one of ordinary skill in the art to employ a needled nonwoven fabric, as taught by Schneider, for the reinforcing layer of Leib. Motivation to do so would be the inherent advantages of said nonwoven, such as strength and uniformity. Therefore, claim 88 is rejected as being obvious over the cited prior art.

8. Claims 80, 106, and 109 are rejected under 35 USC 103(a) as being unpatentable over the cited Leib reference.

Leib does not explicitly teach a weight ratio of the woven component to the nonwoven component. However, as noted above, Leib teaches one woven component having a basis weight of 2.75 oz/yd<sup>2</sup>. When employing a woven component of this basis weight and a spunbond nonwoven component of about 2.0 oz/yd<sup>2</sup>, as is known in the art, the weight ratio would be within the range claimed (i.e., 1.4). Thus, it would have been obvious to one skilled in the art to select the basis weights of the nonwoven and woven components and, hence, the weight ratio of the two, within the range presently claimed. Specifically, the weights of each component are known in the art and selection of each would be a matter of discovering an optimum value of result effective variables such as overall carpet weight, strength, and cost. *In re Boesch*, 205 USPQ 215. Therefore, claims 80, 106, and 109 are rejected as being obvious over the cited prior art.

9. Claims 91, 103, and 111 are rejected under 35 USC 103(a) as being unpatentable over the cited Leib reference.

Leib does not explicitly state the reinforcing nonwoven material is of polyester. However, it would have been obvious to one skilled in the art to substitute polyester filaments for the polypropylene filaments disclosed by Leib. It has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use. *In re Leshin*, 125 USPQ 416. It is the examiner's position that one skilled in the art would recognize polyester fibers as suitable for the intended use. Therefore, claims 91, 103, and 111 are rejected.

#### ***Response to Arguments***

10. Applicant's arguments filed with the Amendment of June 2, 2003 have been fully considered but they are not persuasive.

11. Applicant's new claims differ from cancelled claims 50-73 in that the primary backing is now limited to "consisting essentially of" language. Applicant asserts that said amendment is sufficient to overcome the Leib rejection in that it excludes the presence of the a third nonwoven staple fiber capping layer disclosed by Leib (Amendment, page 10, 1<sup>st</sup> paragraph). The examiner respectfully disagrees.

12. According to MPEP 2111.03, *Transitional Phrases*, the phrase "consisting essentially of" limits the scope of a claim to the specified materials or steps "and those that do not materially affect the basic and novel characteristic(s)" of the claimed invention. *In re Herz*, 537 F.2d 549, 551-52, 190 USPQ 461, 463 (CCPA 1976) (emphasis in original). "A consisting essentially of"

claim occupies a middle ground between closed claims that are written in a “consisting of” format and fully open claims that are drafted in a “comprising” format.” *PPG Industries v. Guardian Industries*, 156 F.3d 1351, 1354, 48 USPQ2d 1351, 1353-54 (Fed. Cir. 1998). For the purposes of searching for and applying prior art under 35 U.S.C. 102 and 103, absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, “consisting essentially of” will be construed as equivalent to “comprising.” See, e.g., *PPG*, 156 F.3d at 1355, 48 USPQ2d at 1355 (“PPG could have defined the scope of the phrase consisting essentially of” for purposes of its patent by making clear in its specification what it regarded as constituting a material change in the basic and novel characteristics of the invention.”). See also *In re Janakirama-Rao*, 317 F.2d 951, 954, 137 USPQ 893, 895-96 (CCPA 1963). If an applicant contends that additional steps or materials in the prior art are excluded by the recitation of “consisting essentially of,” applicant has the burden of showing that the introduction of additional steps or components would materially change the characteristics of applicant’s invention. *In re De Lajarte*, 337 F.2d 870, 143 USPQ 256 (CCPA 1964). See also *Ex parte Hoffman*, 12 USPQ2d 1061, 1063-64 (Bd. Pat. App. & Inter. 1989).

13. Thus, the examiner contends that the amendment to “consisting essentially of” language is insufficient to overcome the prior art of Lieb. Specifically, it is asserted that the Lieb primary backing use of three layers, as opposed to the claimed two layers, would not materially affect the basic novel characteristics of the present invention. In other words, the use of a staple fiber capping layer would not materially affect the improved dimensional stability and healability of the present invention. The burden is upon applicant to set forth what exactly are the basic and

novel characteristics of the invention and to prove the introduction of the capping layer would materially change the basic and novel characteristics of the invention.

***Conclusion***

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

15. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Cheryl Juska whose telephone number is 703-305-4472. The Examiner can normally be reached on Monday-Friday 10am-6pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Terrel Morris can be reached on 703-308-2414. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



CHERYL A. JUSKA  
PRIMARY EXAMINER

cj  
October 6, 2003